

REMARKS**1. CLAIMS STATUS**

Claims 1-57 are hereby cancelled herein without prejudice.

New claims 58-60 are added and pending in the present application. Consideration of same is respectfully requested.

2. AFFIRMATION OF PRIOR ELECTION BASED ON RESTRICTION AND ELECTION OF SPECIES

In the Office Action dated July 29, 2003, the Examiner imposed restriction and election of species requirements against claims 1-57 and required that an election be made between:

Claims 1 and 3-10, drawn to compounds, classified in class 556, subclass 400+;

Claim 2, drawn to a method of making, classified in class 556, subclass 400+; and

Claims 11-57, drawn to CVD process, classified in class 438, subclass 600+;

to which applicant elected Group I, claims 1 and 3-10, including a species election corresponding to claim 1.

Applicant hereby affirms the election, with traverse, of Group I, claims 1 and 3-10, as well as the species identified by claim 1.

Consistent with the species requirement, applicant has cancelled herein all pending claims, while adding new claims 58-60 in an effort to more clearly delineate the elected species.

The cancellation of claims 1-57 herein is with express reservation of the right to file divisional and/or continuation application(s) directed to the subject matter thereof, during the pendency of the present application or a further divisional or continuation application based on and claiming the priority of the instant application.

U.S. Patent Application Serial No. 09/811,106

ATMI-513

3. ADDITION OF NEW CLAIMS 58-60

New claims 58-60 address for purposes of prosecution on the merits, only the instant, elected species.

Accordingly, the cancellation of claims 1-57 without prejudice, is not for purposes of patentability but for clarification and prosecution of the elected species. And in no way is the present amendment and corresponding cancellation of claims intended to limit the scope of the present application under the Doctrine of File Wrapper Estoppel.

4. CLAIM REJECTIONS UNDER 35 U.S.C. § 112

In the October 21, 2003 Office Action, claims 4-6 were rejected as indefinite under 35 U.S.C. § 112 second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, the Examiner states;

“Applicant fails to explicitly define the ligands X and Y. In particular, claim 4 has no definition of ligands X and Y. Claim 6 reference to ligands X and Y is also confusing and indefinite. ...”

Although all currently pending claims are herein cancelled, applicant has heeded the 35 U.S.C. § 112 rejection and has accordingly incorporated definitions for both X and Y ligands into new claims 58-60.

New claims 58-60 introduce no new subject matter and are definite within the meaning of 35 U.S.C. § 112.

On the basis of the foregoing, applicant respectfully requests that the Examiner withdraw the October 21, 2003, 35 U.S.C. § 112 rejection.

U.S. Patent Application Serial No. 09/811,106

ATMI-513

5. RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 1 and 3-10 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,313, 648, issued to Johnson et al., (hereinafter referred to as "Johnson"). The Examiner reasons that Johnson anticipates the present invention, because Johnson discloses the compound of the present claim 1.

Applicant respectfully requests that the rejection of claims 1 and 3-10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,313,648 be withdrawn, as the rejection is moot in light of the cancellation of such claims.

6. NEW CLAIMS 58-60 IN LIGHT OF PREVIOUSLY CITED PATENT 3,313,648

With respect to the aforementioned 35 U.S.C. § 102(b) rejection, applicant has added new claims 58 - 60 and submits that such claims are novel and unobvious over U.S. Patent 3,313,648, to Johnson, et al..

Johnson is directed to modifying solid materials (surfaces) with certain organo-silicon compounds to cause normally hydrophilic surfaces to be hydrophobic (See Johnson, column 1, lines 15-19). More specifically, at column 5, lines 29-45:

Organo-carboxy silanes can be and are preferably employed having the structural formula



wherein n is a number selected from the group consisting of 1 and 2, R is a radical selected from the group consisting of an aliphatic hydrocarbon radical having from 1 to 3 carbon atoms in the molecule, and R' is selected from the group consisting of H and an aliphatic hydrocarbon radical having from 1 to 5 carbon atoms in the molecule.

Applicant's new claims 58 - 60 are directed to organosilanes comprising combinations of ligands not contemplated by Johnson, as Johnson teaches the necessity of using only certain and specific organo-carboxy silanes. Accordingly, new claims 58-60 are fully patentably distinguished over Johnson and in condition for allowance.

U.S. Patent Application Serial No. 09/811,106

ATMI-513

7. PETITION UNDER 37 CFR 1.136 FOR THREE-MONTH EXTENSION OF TIME

Petition hereby is made under the provisions of 37 CFR 1.136 for a three month extension of the term for response to the October 21, 2003 Office Action, extending the term for response to April 21, 2004.

8. FEES DUE AND PAYABLE

In connection with applicant's Petition Under 37 CFR 1.136 for Three Month Extension of Time, a fee of \$950 as specified in 37 C.F.R. §1.17(a)(3), is hereby authorized to be deducted from Deposit Account No. 50-0860 in the name of applicant, Advanced Technology Materials, Inc., 7 Commerce Drive, Danbury, CT 06810.

The addition of new independent claims 58-60 together with the cancellation of claims 1-57 herein does not result in any net addition of claims (independent or total) beyond the number for which payment was previously made. Nonetheless, if any charge or fee is determined to be properly payable in connection with the filing and entry of this Amendment, the same hereby is authorized to be charged to applicant's Deposit Account No. 50-0860, in the name of Advanced Technology Materials, Inc.

Should the Office determine any additional fees are due in connection with the entry of this amendment, the Office is hereby authorized to deduct such fee from applicant's above referenced Deposit Account.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, applicant respectfully requests reconsideration of this application and full allowance of claims 58-60.

U.S. Patent Application Serial No. 09/811,106

ATMI-513

In the event that any issues remain outstanding, incident to the formal allowance of the application, the Examiner is requested to contact the undersigned agent at (203) 739-1435 to discuss their resolution, so that this application may be passed to issue at an early date.

Respectfully submitted,



Margaret Chappuis
Registration No. 45,735
Agent for Applicant

Advanced Technology Materials, Inc.
7 COMMERCE DRIVE
DANBURY, CT 06810
Phone: 203 794-1100
Facsimile: 203 797-2544
Agent's Direct Line: 203 739-1435
Attorney Docket: 513